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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. FINCH

Appeal 2008-2562
Application 09/844,747
Technology Center 2400

Decided: January 23, 2009

Before JOSEPH L. DIXON, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-35. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

The disclosed invention relates generally to communications systems. More particularly, the present invention relates to multi-PHY communication without an ATM bus master. (Spec. 1, ll. 6-7).

Independent claim 1 is illustrative:

1. A communications system, comprising:
 - a bus including at least one data line and control lines;
 - a first device coupled to the bus;
 - a second device coupled to the bus, the data lines being coupled between the first and second devices; and
 - a handshaking unit coupled to the control lines of the bus and being adapted to determine if the first and second devices are capable of completing a data transfer and enable the first and second devices to facilitate the data transfer.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the anticipation and obviousness rejections:

Rumer	US 6,618,376 B2	Sep. 9, 2003 (filed Mar. 14, 2001)
Skokan	US 5,412,783	May 2, 1995 (filed Jul. 2, 1993)

THE REJECTIONS

1. The Examiner rejected claims 1-3, 5, 25-27, and 29 under 35 U.S.C. § 102(b) as being anticipated by Skokan.
2. The Examiner rejected claims 4, 6-24, 28, and 30-35 under 35 U.S.C. § 103(a), as being unpatentable over Skokan in view of Rumer.

“[T]he examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Therefore, we look to Appellant’s Briefs to show error in the proffered *prima facie* case.

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

APPELLANT’S CONTENTIONS

1. Appellant contends that Skokan fails to teach the limitation of “a handshaking unit coupled to the control lines of the bus” (App. Br. 6).
2. Appellant also contends that Skokan teaches that the bus disclosed in Skokan contains separate control lines which do not carry handshaking signals. (Id.).

ISSUE

Has Appellant shown the Examiner erred in determining that Skokan discloses “a handshaking unit coupled to the control lines of the bus,” and “providing handshake signals on the control lines?”

PRINCIPLES OF LAW

Anticipation under 35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

FINDINGS OF FACT

1. Skokan teaches that handshake signals are included in the timing signals 12 provided by connecting network segment 10. (Col. 3 ll. 18-20, 35-38 and 50-53; Fig. 2).

ANALYSIS

As discussed above, Appellant contends that Skokan fails to disclose a handshaking unit coupled to the control lines of the bus, and providing handshake signals on the control lines. We agree.

The Examiner contends that Skokan clearly discloses a handshaking unit being adapted to determine and facilitate the data transfer. The Examiner further contends that Skokan clearly teaches a simple handshaking unit (e.g., a handshake signal). (Ans. 7).

We note that claims 1 and 13 recite a handshaking unit in the form of structural element as shown in Appellant's Fig. 1 ref. 50. The claimed handshaking unit not only provides the handshaking signals, but is also coupled to the control lines. It is our reasoned conclusion that neither of these claimed limitations is disclosed in Skokan.

Skokan teaches that handshake signals are included in the timing signals 12 provided by connecting network segment 10 (FF 1). Thus, Skokan is silent as to the handshaking signals being provided by a unit coupled to the control lines, since the handshaking signals are described as part of the timing signals (FF 1). Thus, we find that Skokan does not explicitly disclose a handshaking unit coupled to control lines. The Examiner further contends the handshaking signals as shown in Figs. 3-5 are inherently coupled to the control bus, based on the teachings of Figs. 3-5. (Ans. p. 6). However, we agree with Appellant's assertion that according to Skokan, the handshaking signal is a separate entity (included in the timing signals 12, FF 1) and is not coupled to the control lines 13. (Reply Br. p. 3). The standard for anticipation according to Section 102 of Title 35 requires that the reference discloses the limitations *to be combined in the same manner as claimed*.

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed *but also all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc. v. VeriSign et al., 545 F.3d 1359, 1371 (Fed. Cir. 2008)(emphasis added).

For the reasons discussed above, we find that Skokan does not disclose the limitation of a handshaking unit coupled to the control lines, as recited in independent claims 1 and 13, or providing the handshaking signals on the control lines, as recited in independent claim 25.

Based on the record before us, we conclude that Appellant has shown that the Examiner erred in determining that Skokan discloses the limitations of “a handshaking unit coupled to the control lines of the bus,” and “providing handshake signals on the control lines.” Accordingly, we reverse the Examiner’s rejections of claims 1, 13, and 25, and dependent claims 2, 3, 5, 26, 27, and 29, under 35 U.S.C. § 102(b) as being anticipated by Skokan.

Obviousness under 35 U.S.C. § 103

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Claims 4, 6-24, 28, and 30-35

We next consider the Examiner's rejection of claims 4, 6-24, 28, and 30-35 under 35 U.S.C. § 103(a) as being unpatentable over Skokan in view of Rumer.

We note that claims 4, 6-24, 28, and 30-35 depend from claims 1, 13, and 25 respectively. The Examiner has not shown, nor do we find, that Rumer cures the deficiencies of Skokan that were discussed *supra* with respect to claims 1, 13, and 25. Accordingly, we reverse the Examiner's rejection of claims 4, 6-24, 28, and 30-35 under 35 U.S.C. § 103(a) as unpatentable over Skokan in view of Rumer.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

Appellant has shown that the Examiner erred in determining that Skokan teaches the claimed limitations of "a handshaking unit coupled to the control lines of the bus," and "providing handshake signals on the control lines."

DECISION

The decision of the Examiner rejecting claims 1-3, 5, 25-27, and 29 under 35 U.S.C. § 102(b) is reversed.

The decision of the Examiner rejecting claims 4, 6-24, 28, and 30-35 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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